

REMARKS

Claims 1 to 20 are pending. Claim 11 has been withdrawn.

Reconsideration of the application is requested.

Interview

The undersigned acknowledges with appreciation the in-person interview granted by Examiner Thanh Duong on August 26, 2009.

Election/Restrictions

Applicant still maintains for the reasons previously provided that Groups I (claims 1-10 and 12-20) and II (claim 11, which depends from claim 1, which in turn depends from claim 12) share at least one feature that renders the claims patentable over WO 94/16134.

§ 103 Rejections

Claims 1-10 and 12-20 stand rejected under 35 USC § 103(a) as being unpatentable over WO 98/35144 in view of U.S. Pat. No. 5,290,522 (Rogers t al.).

The rejection of claims 1-10 and 12-20 under 35 USC § 103(a) as being unpatentable over ‘144 in view of ‘522 (Rogers t al.) should be withdrawn as Applicant disagrees with the conclusion and reasoning.

Independent claim 12 claims a mat for mounting a pollution control element in a casing of a pollution control device, said mat being a non-intumescent mat comprising at least 90% by weight based on the total weight of the mat of chopped magnesium aluminium silicate glass fibers that have a number average diameter of 5µm or more and a length of 0.5 to 15cm, said glass fibers being needle punched or stitch bonded, said mat being free or substantially free of organic binder and being comprised of at least two layers of said chopped magnesium aluminium silicate glass fibers, wherein said at least two layers differ in their magnesium aluminum silicate glass fiber composition.

As discussed at the in-person interview, at least 3 different modifications of ‘144 are required to provide the invention claimed in claim 12. That is, one skilled in the art, absent the inappropriate use of hindsight analysis, would need to be (1) properly motivated to make a non-intumscent mat whereas ‘144 requires at least one intumescent layer, (b) then be properly motivated to have at least two layers of magnesium aluminum silicate glass fibers, even though there is no teaching or suggestion in ‘144 of using two such specific layers, and (3) then be properly motivated to have at least of the magnesium aluminum silicate glass fibers have a different composition, when again there is no teaching or suggestion in ‘144 of using two such specific layers, let alone of the two having different compositions. It is submitted that notwithstanding the reasons provided in the Office Action, one skilled in the art would not be properly motivated absent the inappropriate use of hindsight analysis. Further, given the teachings of ‘144, it is submitted the reasoning provided in the Office Action is insufficient to support the conclusion of obviousness.

Moreover, claim 12 claims a non-intumescent mat whereas ‘144 always requires an intumescent layer, and optional can have additional layers, including at least one non-intumescent layer. It would be understood by one skilled in the art reading ‘144 that the ‘144 is

teaching an intumescent mat, which is the opposite of a non-intumescent as claimed in claim 12. Therefore, to modify '144 as proposed to make a non-intumescent would be to destroy the teachings of '144, and hence there is no proper motivation provided in the Office Action provided to combine '144 and '522 (Rogers et al.).

Claims 1-11 and 13-20 depend directly or indirectly from claim 12. Claim 12 is patentable, for example, for the reasons given above. Therefore, claims 1-11 and 13-20 are also patentable.

In summary, the rejection of claims 1-10 and 12-20 under 35 USC § 103(a) as being unpatentable over '144 in view of '522 (Rogers et al.) should be withdrawn.

In view of the above, it is submitted that the application is in condition for allowance.

Respectfully submitted,

September 14, 2009

Date

By: /Gregory D. Allen/

Gregory D. Allen, Reg. No.: 35,048

Telephone No.: 651-736-0641

Office of Intellectual Property Counsel
3M Innovative Properties Company
Facsimile No.: 651-736-3833